

REMARKS

Claims 1 through 72 are pending in the application. Claims 1, 2, 5, 7, 10, 11, 14, 16, 19, 20, 23, 25, 28, 30 through 32, 39, 41 through 43, 50, 52 through 54 and 70 have been amended. Reconsideration of this application is respectfully requested.

The Office Action has objected to the specification on the ground that the amended description regarding Fig. 16 in the paragraph that begins at page 16, line 3, is inconsistent with Fig. 16. This paragraph has been amended in the manner suggested by the Examiner. Accordingly, it is submitted that the amendment obviates the objection to the specification and, therefore, that the objection should be withdrawn.

The Office Action has objected to the drawing because the "Y" legend adjacent box 360 in Fig. 13 should be deleted. Fig. 13 has been so amended by a replacement sheet appended hereto subject to the approval of the Examiner. Therefore, it is submitted that the objection to Fig. 13 of the drawing is obviated by the amendment and should be withdrawn.

The Office Action has further objected to the drawing because Fig. 16 is inconsistent with the description thereof in the paragraph that begins at page 16, line 3. As noted above in the discussion of the objection to the specification, the specification has been amended in the manner suggested by the Examiner to remove the inconsistency. Therefore, it is submitted that the objection to Fig. 16 of the drawing is obviated by the amendment and should be withdrawn.

In dependent claims 1, 10, 19, 28, 39 and 50 have been amended to clarify the relationship between the characters and the character positions by reciting that each of the plurality of labels includes at least one character group

disposed in a plurality of character positions. Dependent claims 2, 5, 7, 11, 14, 16, 19, 20, 23, 25, 30 through 32, 41 through 43, and 52 through 54 have been amended to provide antecedent consistency with "character position" recited in their respective independent claims. Claim 70 has been amended to delete a repetition of "that".

The Office Action rejects claims 1 through 7, 9 through 16, 18 through 25, 27 through 60 and 70 through 72 under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 4,718,784 to Drisko, hereafter Drisko.

This rejection is erroneous because Drisko lacks one or more elements recited in these claims. Drisko discloses a computer system 20 that has a plurality of label designs stored on a disk 28 (column 3, lines 53-59). Computer system 20 also includes software stored in ROM 26 that controls a CPU 24 to print user selected ones of the label designs stored on disk 28. The Examiner alleges that Drisko discloses that various entries of data by the user includes various items listed at A through G in Paragraph No. 7.1.1. However, Drisko does not disclose that the user can input items A through F. Drisko discloses only the following user entries to control the printing process:

"When the user selects a set of labels to be printed, the user specified (1) the label designs to be printed, (2) the quantity of each label design to be printed and (3) the printing pattern, which specifies the order in which the labels are to be printed." (column 4, lines 59-64)

"...the user can specify that text lines are to be automatically centered when printed." (column 6, lines 17-19)

"The preferred embodiment allows the user to increase or decrease the height of the bars." (column 6, lines 64-66)

"The user then specifies or selects, by means of the keyboard, the label designs which he wants to print (boxes 62-64)." (column 8, lines 41-43)

"...the user specifies the quantity of each label to be printed, and the printing mode (box 66)." (column 8, lines 49 and 50)

Based on these user entries, Drisko teaches that a user can select from the label designs stored on disk 28 a label design and the quantity thereof to be printed, an increase or decrease of the height of the bars of a bar code of the selected label design, automatic centering of the text lines of the selected label design, and the order in which the labels of the selected label design are to be printed. Drisko contains no disclosure or teaching of how to create the label designs using a computer. Drisko merely teaches that the label designs are stored on disk 28. It is clear that the label designs are created, not by Drisko's system, but by some other system. Thus, contrary to the Examiner's allegation that a user of Drisko's system may create custom label designs, Drisko's software merely permits user selection of a pre-existing label design.

In contrast, independent claims 1, 10 and 19 recite steps that are performed by a computer in response to user entries to form a plurality of labels in a single job. Thus, in response to a first user entry, a label is defined with alphanumeric content for one or more positions of a label. This step is repeated to form a plurality of labels that includes at least one label that is unrelated in numerical sequence to any of the other labels of the plurality of labels. Drisko does not teach that his software has any capability to respond to user entries to form a plurality of labels as claimed in claims 1, 10 and 19. Rather, Drisko merely teaches software that controls the printing of a pre-existing label design that is selected from disk 28 by a user.

Drisko further mentions at column 3, lines 61 and 62, that keyboard 32 "...is also used for inputting label designs". However, Drisko is silent as to how any such designs are entered. Consistent with Drisko's teaching of a user selecting a pre-existing label design, the teaching of using keyboard 32 to input label designs would be to transfer pre-existing label designs from another source, such as a library, to disk 28.

In Paragraph No. 7.1.2 of the Office Action, the Examiner begins the first sentence with "...after the user has designed one or more labels". In Paragraph No. 10.2 (A), the Examiner begins with "since one of ordinary skill in the art would have recognized that the collection of labels designed in Drisko". In Paragraph No. 10.2(B), the Examiner begins with "...Drisko clearly teaches that the user may designate content of each label". As noted above, Drisko does not disclose or teach any capability for a user to design a label or to designate the content thereof. Therefore, the arguments made in Paragraph Nos. 7.1.2 and 10.2(A) and (B) are predicated on an erroneous interpretation of Drisko and, therefore, are untenable.

In Paragraph No. 7.1.3 of the Office Action, the Examiner alleges that Drisko permits the user to designate the content of the label. However, as noted above, Drisko's system does not permit the user to designate the alphanumeric content of a label. Drisko merely permits the user to select a pre-existing label design. In Paragraph No. 10.2(B), the Examiner cites step 62 of Fig. 6 as support for the contention that Drisko's system allows user entry of alphanumeric content to a label. However, step 62 merely responds to a user selection of a label design from disk 28 (column 8, lines 41-43) and does not respond to user input of alphanumeric content for a label.

In Paragraph Nos. 7.1.3, 10.2 (C) and (D), the Examiner further alleges that the ability to designate the content of the label is non functional descriptive material, citing *In re Gulack*, 217 USPQ 401. This case involved a rejection under 35 U.S.C. 103 and, therefore, is inapplicable to a rejection under 35 U.S.C. 102. Therefore, the contention is untenable. The Examiner contends that *Gulack* is applicable to patentability issues under 35 U.S.C. 102. However, the Examiner does not cite any authority that supports his contention. The MPEP only mentions *In re Gulack* in Section 2106 as applicable to considerations under 35 U.S.C. 103 with respect to differences found between the claimed invention

and a prior art reference. Gulack was decided based on a Section 103 rejection and, therefore, does not apply to section 102 considerations.

In Paragraph No. 7.1.4 regarding claims 2 through 4, 11 through 13, 40, 43, 44, 51, 54 and 55, the Examiner alleges that "...one of ordinary skill in the art would know that it is common practice to set forth to the user various options by presenting to the user a palette or a display showing a number of possible positions/colors/fonts available to the user". The rejection of these claims is under 35 U.S.C. 102(b) as anticipated by Drisko and not under 35 U.S.C. 103(a) as obvious over Drisko in view of the knowledge of one of ordinary skill in the art. It is submitted that the Examiner's allegation is erroneous and without any authoritative support.

Moreover, Drisko does not disclose or teach that the user can control the positional palette of the positions of the label as claimed in claims 2 through 4, 11 through 13, 40, 43, 44, 51, 54 and 55. Drisko's software responds only to the user inputs that are noted above, which do not include any control over the positional palette of the positions of the label.

Drisko does not teach "assigning a first positional palette" as recited in independent claims 28, 39 and 50. Drisko's software responds only to the user inputs that are noted above, which do not include any control over the positional palette of the positions of the label.

In Paragraph No. 10.2 (E) of the Office Action, the Examiner alleges that "...since one of ordinary skill in the art would have recognized from Figs. 4, 5A and 5B of Drisko that the system of Drisko (1) permits the user to design a label by selecting the colors/fonts/text which is to appear on the label". This allegation is erroneous since Drisko's system has no capability for a user to design a label or to select the colors/fonts/text of the label. Rather, Drisko's user merely selects a pre-existing label from disk 28 and makes changes as noted in the above

reproduced passages of Drisko, which do not include designing a label by selecting colors/fonts/text. Accordingly, the arguments made in Paragraph No. 10.2(e) are predicated on an erroneous interpretation of Drisko and, therefore, are untenable.

In Paragraph No. 10.2(E) of the Office Action, the Examiner contends that one of ordinary skill in the art would have recognized that Drisko "...would inherently include the ability for the user of placing desired color/text any appropriate/desired location on the label". The contention of inherency is traversed. One of ordinary skill in the art has no reason to make such a conclusion because Drisko has no capability for user selection of designating a positional palette of a character position. Drisko's user merely selects a pre-existing label design and makes entries noted in the Drisko passages reproduced above, namely, a quantity of the selected pre-existing label design to be printed, an increase or decrease of the height of the bars of a bar code of the selected label design, automatic centering of the text lines of the selected label design, and the order in which the labels of the selected label design are to be printed. These selections do not provide any foundation for one of ordinary skill in the art to make the conclusion suggested by the Examiner. Therefore, the contention of inherency is erroneous.

Drisko does not teach the user interface recited in independent claims 70 and 72, because Drisko's user interface would be limited to the user actions noted in the above reproduced passages from Drisko, which do not include the ability of the "...user to define by user entry a plurality of labels that are unrelated in alphanumeric content or color". The Drisko passages do not teach the claimed user capability.

For the reason set forth above, it is submitted that the rejection of claims 1 through 7, 9 through 16, 18 through 25, 27 through 60 and 70 through 72 under 35 U.S.C. 102(b) as anticipated by Drisko is erroneous and should be withdrawn.

The Office Action rejects claims 8, 17, 26 and 61 through 69 under 35 U.S.C 103(a) as unpatentable over Drisko as applied to claims 1 through 7, 9 through 16, 18 through 25 and 27 through 60 and further in view of obvious variations.

This rejection is erroneous for a number of reasons. First, Drisko lacks steps or elements recited in respective parent claims 1, 10 and 19 of claims 8, 17 and 26 as pointed out in the above discussion of the rejection of the respective parent claims under 35 U.S.C. 102(b). Since the elements or steps are lacking in Drisko and the variations noted in the Office Action do not supply them, a prima facie case has not been made for obviousness.

In the first sentence of Paragraph No. 8.1.1, the Examiner admits that Drisko does not permit the user to designate a rotational orientation for the bar code, but contends that "Drisko does permit the user to define the exact location of the barcode on the label relative to the other information on the label". This contention is erroneous. Drisko merely teaches a system that allows a user to select a pre-existing label design from disk 28 and, in the case of a bar code, Drisko's software reacts only to a user input to alter the height of the bars of a bar code. See column 6, lines 64-66, reproduced above. Therefore, The teachings of Drisko clearly do not support Drisko's user defining "the exact location of the barcode on the label relative to the other information on the label".

In the second sentence of Paragraph No. 8.1.1, the Examiner expands the contended teachings of Drisko to also include a bar code orientation, based on "Drisko not excluding this possibility". The Examiner then concludes that it would have been obvious to one of ordinary skill in the art that Drisko "does permit the user to define a rotational orientation for the barcode and/or text that is to appear on the label".

The expanded teachings do not have any support or basis in Drisko. Drisko teaches a system in which the user selects a pre-existing design from disk 28 and is given limited capability as noted above in the discussion of the Section 102 rejection to make changes to the selected pre-existing label design. Those changes include the ability to change the bar code only in respect to the height of the bars thereof. Drisko is totally silent as to the orientation of the bar code. The conclusion of obviousness is erroneous for two reasons. First, it is based on an erroneous teaching of Drisko as noted above. Second, it is based on "Drisko not excluding this possibility" user changes to bar code orientation. This is pure hindsight, based on Applicants' disclosure. There is no evidence of record upon which to base the conclusion. Drisko contains no suggestion or motivation for one of ordinary skill in the art to modify Drisko by giving the user the ability to alter the orientation of the bar code. Accordingly, the Examiner has not made a prima facie case of obviousness with respect to claims 8, 17 and 26.

This rejection is also erroneous as to claims 61 through 69. The Office Action states that the rejection is as applied to claims 1 through 7, 9 through 16, 18 through 25 and 27 through 60. This does not apply to claims 61 through 69, because independent claim 61 and its dependent claims 62 through 69 are separate and distinct from the claims 1 through 7, 9 through 16, 18 through 25 and 27 through 60.

The Examiner contends that Drisko teaches to keep track of the number of labels printed. Drisko's only teaching concerning the number of labels printed appears at step 66 of Fig. 6. The specification at column 8, lines 49 and 50, states that "the user specifies the quantity of each label design to be printed, and the printing mode box 66." Step 66 merely specifies to the computer how many labels the user wants to print. Drisko contains no teaching of the recitals in claim 61 for managing an inventory of label stock by keeping a current count of labels in the inventory and a warning count, presenting an alert to the user when the current count is less than the warning count and adjusting the current count with

a number of refill labels received in response to an entry by the user and adjusting the current count as labels of the inventory are used.

Also, the Examiner, relying on the unsupported statement discussed above, leaps to a conclusion that it would have been obvious to modify Drisko to provide alterable alert levels. Neither the statement nor Drisko teaches alterable alert levels. For the reason set forth above, a prima facie case of obviousness has not been made with respect to claims 61 through 69.

In Paragraph No. 10.3, the Examiner lists three claimed operations and contends that Drisko teaches the claimed operations. However, Drisko does not teach any of the three operations as discussed above in the discussion of the Section 102 rejection. Hence, a prima facie case of obviousness has not been made.

Also in Paragraph No. 10.3, the Examiner makes a statement that since Applicants have not shown that one of ordinary skill would have had the knowledge of "how to display various pallets to the user and how the user may select one or more of the items in the pallet and keeping track of inventory of labels", applicants' arguments are non-persuasive. This statement is traversed. The burden is on the Examiner, not the Applicants, to cite evidence that supports a prima facie case of obviousness. For the reasons set forth above, the Examiner has not met this burden.

The Examiner seems to be selecting the claimed elements not shown by Drisko and imputing these elements to the knowledge of one of ordinary skill in the art and then concluding that the claims are obvious over Drisko in view of the imputed knowledge. This imputed knowledge and conclusion is improperly based on the hindsight of Applicants' disclosure. Such hindsight reconstruction of the art cannot be the basis of a rejection under 35 U.S.C. 103. The prior art itself must suggest that modification or provide the reason or motivation for

making such modification. In re Laskowski, 871 F.2d 115, 117, 10 USPQ 2d 1397, 1398-1399 (CAFC, 1989). "The invention must be viewed not after the blueprint has been drawn by the inventor, but as it would have been perceived in the state of the art that existed at the time the invention was made." Sensonics Inc. v. Aerosonic Corp. 38 USPQ 2d 1551, 1554 (CAFC, 1996), citing Interconnect Planning Corp. v. Feil, 774 F. 2d 1132, 1138, 227 USPQ 543, 547 (CAFC, 1985).

For the reasons set forth above, it is submitted that the rejection of claims 8, 17, 26 and 61 through 69 under 35 U.S.C. 103(a) is erroneous and should be withdrawn.

It is respectfully requested for the reasons set forth above that the objections to the specification and drawings be withdrawn, that the rejections under 35 U.S.C. 102(b) and 35 U.S.C. 103(a) be withdrawn, that claims 1 through 72 be allowed and that this application be passed to issue.

Respectfully Submitted,

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REPLACEMENT SHEET

